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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/055,104	01/23/2002	Kenneth H. Rosen	1209-2	9643

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Salvatore J. Abbruzzese
HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, NY 11791

EXAMINER	
PEREZ GUTIERREZ, RAFAEL	

ART UNIT	PAPER NUMBER
2686	

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/055,104	Rosen et al.	
	Examiner	Art Unit	
	Rafael Perez-Gutierrez	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 April 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 April 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to Applicant's response filed on April 22, 2005. **Claims 1-46** are still pending in the present application. **This Action is made FINAL.**

Oath/Declaration

2. The declarations filed on January 23, 2002 and on April 22, 2005 are defective. A new declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The declarations are defective because they were executed in accordance with either 37 CFR 1.66 or 1.68. Specifically, the signature of inventor John A. Rotondo is missing.

Drawings

3. The replacement drawing sheets received on April 22, 2005 have been accepted by the Examiner.

Response to Declaration

4. The declaration filed on April 22, 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Sheha et al. reference.

5. The Examiner believes that Applicant has provided sufficient evidence in **Exhibit A** to establish conception of the invention, at least as presently claimed in **claims 1, 17, 32, and 40**, prior to the Sheha et al. reference.

6. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Sheha et al. reference to either a constructive reduction to practice or an actual reduction to practice.

From the period of at least **Exhibit B** (or from a date prior to July 17, 2001) to **Exhibit C** (September 21, 2001) Applicant fails to establish diligence since the entire period from a date prior to July 17, 2001 to September 21, 2001 is not accounted for. The Examiner notes that it seems that Applicant is adding or clarifying new concepts to the invention at least on or after September 21, 2001 since Applicant's representative states "...we need to elaborate more in the feature of preventing to storage of the wireless caller's location information in the network". Additionally, Applicant states that **Exhibit C** provides a first draft of the patent application on September 21, 2001, however, Applicant has not provided the actual draft of the patent application for evidence.

From the period of **Exhibit C** (September 21, 2001) to **Exhibit D** (December 5, 2001) Applicant fails to establish diligence since the entire period from September 21, 2001 to December 5, 2001 is not accounted for. Applicant states that **Exhibit D** provides a final draft of the patent application on December 5, 2001, however, Applicant has not provided the actual final draft of the patent application for evidence.

Finally, from the period of **Exhibit D** (December 5, 2001) to the filing of the present application (January 23, 2002) Applicant fails to establish diligence since the entire period from December 5, 2001 to January 23, 2001 is not accounted for.

An Applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959).

Therefore, in view of the above reasons, the previous rejections based in whole or in part on the Sheha et al. reference are maintained and made FINAL by the Examiner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

> A person shall be entitled to a patent unless -- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-16 and 40-46 are rejected under 35 U.S.C. 102(e) as being anticipated by **Sheha et al. (U.S. Patent Application Publication # 2003/0016804 A1)**.

Consider **claims 1 and 40**, Sheha et al. clearly show and disclose a method and a system for transferring selective location information of a wireless calling party 18b to a called party 18c (figure 3), comprising:

a telecommunications network 22 coupled to a wireless telephone device 18b for receiving a telephone call from the wireless calling party 18b (figure 3 and paragraphs 0014, 0021-0023, 0046, and 0048-0052);

a database 3 within the network 22 for storing service information of the wireless calling party 18b, wherein the service information includes instructions regarding the selective transfer of the location information (figure 3, paragraphs 0014, 0021-0023, 0046, and 0048-0052, and claims 1, 20, 26, 45, 51, 71, 76, and 96); and

the telecommunications network 22 further retrieves the service information from the database 3 and transfers the selective location information to the called party 18c (figure 3, paragraphs 0014, 0021-0023, 0046, and 0048-0052, and claims 1, 20, 26, 45, 51, 71, 76, and 96).

Consider **claims 2-16 and 41-46**, and **as applied to claims 1 and 40 above**, Sheha et al. also show and disclose the claimed limitations in the abstract, figures 3-5, 8, and 9, paragraphs 0014, 0021-0023, 0046, and 0048-0052, and claims 1-110.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. **Claims 17-39** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Sheha et al. (U.S. Patent Application Publication # 2003/0016804 A1)** in view of **Hashimoto (U.S. Patent # 5,341,411)**.

Consider **claims 17 and 32**, Sheha et al. clearly show and disclose a method of transferring selective location information of a wireless calling party 18b to a called party 18c (figure 3), comprising:

receiving a string of numbers from the wireless calling party 18b, whereby the string of numbers is inclusive of the called party's 18c telephone number (figure 3, paragraphs 0014, 0021-0023, 0046, and 0048-0052, and claims 1, 20, 26, 45, 51, 71, 76, and 96);

receiving a code/pre-defined number, the code/pre-defined number includes instructions regarding blocking the selective transfer of the location information (paragraphs 0014, 0021-0023, 0046, and 0048-0052, and claims 1, 20, 26, 45, 51, 71, 76, and 96); and

transmitting or blocking the transmission of the selective location information of the wireless calling party to the called party/network (figure 3, paragraphs 0014, 0021-0023, 0046, and 0048-0052, and claims 1, 20, 26, 45, 51, 71, 76, and 96).

However, Sheha et al. do not specifically disclose that the code/pre-defined number is among the string of numbers received.

In the same filed of endeavor, Hashimoto clearly discloses retrieving a blocking key (code/pre-defined) number among a string of numbers, said blocking key (code/pre-defined) number providing instructions regarding blocking transmission of caller information (abstract, column 1 lines 18-47,and claims 1, 2, and 10).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to specify a blocking key number feature as taught by Hashimoto in the method disclosed by Sheha et al. for the purpose of allowing easier manual intervention.

Consider **claims 18-31 and 33-39**, and **as applied to claims 17 and 32 above**, Sheha et al., as modified by Hashimoto, also show and disclose the claimed limitations in the abstract, figures 3-5, 8, and 9, paragraphs 0014, 0021-0023, 0046, and 0048-0052, and claims 1-110.

Conclusion

10. **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rafael Perez-Gutierrez whose telephone number is (571) 272-7915. The Examiner can normally be reached on Monday-Thursday from 6:30am to 5:00pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Marsha D. Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Rafael Perez-Gutierrez
R.P.G./rpg RAFAEL PEREZ-GUTIERREZ
PRIMARY EXAMINER
September 22, 2005